

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 24

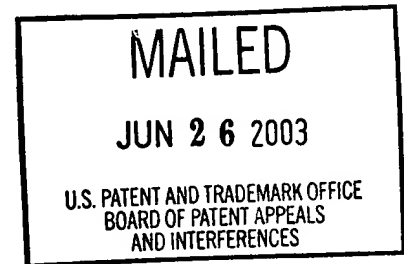
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREAS WALDER

Appeal No. 2003-1068
Application No. 09/082,309

ON BRIEF



Before KIMLIN, WALTZ, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 16-26, 28, and 29.

Claim 16 is representative of the subject matter on appeal and is set forth below:

16. A method, which does not use extruders, for the productions of expandable plastics granulate from a plastics melt and a fluid blowing agent that is, when at a pressure within a predetermined pressure range, only partly soluble in the melt, the method comprising the steps of:

- dispersing the blowing agent in the melt with shearing of the melt thereby creating a mixture;
- retaining the mixture within a predetermined pressure range for a predetermined retention time;
- subjecting the mixture to less shearing, with respect to the shearing during the dispersing step, during the predetermined retention time;
- cooling the mixture to a temperature that is above the solidification temperature of the melt;
- granulating the cooled mixture; and
- acting on the mixture with static mixer elements;

and

wherein the dispensing of the blowing agent and the retaining of the mixture is carried out in a single apparatus in which the mixture is acted upon continuously by means of the static mixing elements as the mixture moves through the apparatus for avoiding segregation.

On page 3 of the Brief, appellant states that the claims stand or fall with claim 16. We therefore consider claim 16 in this appeal. 37 CFR § 1.192(c)(7)(8)(2000).

Claims 16-26, 28, and 29 stand rejected under 35 U.S.C. § 112, first paragraph (description).

OPINION

For the reasons set forth in the Answer and below, we affirm the rejection.

The examiner's position is that the limitation, "which does not use extruders", in line 1 of claim 16, is not supported by appellant's original disclosure. (Answer, page 3).

The examiner refers to page 5, lines 25-27 of appellant's specification in support of his position. Also, on page 4 of the Answer, the examiner refers to page 6, lines 5-6 of appellant's specification in support of his position. The examiner believes that these parts of the specification show that the use of extruders occurs in appellant's method as claimed in claim 16.

In the Brief and in the Reply Brief, appellant argues that the method recited in claim 16 begins after the heating process set forth on page 5 at lines 25-27 of the specification.

We observe that the concept of exclusion is not expressly supported by the specification, and we refer to the case of Ex parte Grasselli, 231 USPQ 393, 394 (Bd. App. 1983) in this regard. In this case, the Court agreed with the examiner's position that the negative limitations recited in the claims which did not appear in the specification as filed, introduced new concepts and violate the description requirement of the first paragraph of 35 U.S.C. § 112. See also In re Anderson, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

In the present case, the negative limitation of "which does not use extruders" does not appear in the specification as filed. In fact, we note that the original claims as filed do not set forth this negative limitation. Some of the original claims recite, for example, the requirement of a heated extruder

(original claims 4, 13, and 14). We particularly note that claim 4, as originally filed, concerns the granulation step. This step is described on page 6 at lines 5-7 of appellant's specification, as pointed out by the examiner on page 6 of the Answer. This step does not occur during the heating process, but concerns the step regarding granulating the cooled mixture, that is recited in claim 16. Hence, appellant's argument that the method recited in claim 16 begins after the heating process is unconvincing.

We therefore determine that the phrase "which does not use extruders" is not supported by the original specification. Id. In so doing, we also determine that this disclosure does not reasonably convey to persons skilled in the art that the appellant had possession of the subject matter in question. See In re Edwards, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978).

In view of the above, we therefore affirm the 35 U.S.C. § 112, first paragraph (description) rejection of the claims.

CONCLUSION

To summarize, the rejection made by the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Edward (Killer)

EDWARD C. KIMLIN
Administrative Patent Judge

Thomas A. West

THOMAS A. WALTZ
Administrative Patent Judge

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Appeal No. 2003-10

Application No. 09/082,309

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